

## **REMARKS**

The Office Action dated December 5, 2004 has been carefully reviewed. Claims 31-44 are pending in this patent application. Reconsideration of this application is respectfully requested.

### **Drawing Objections**

The drawings were objected to because it was alleged that they did not show planes P1 and P2. As the patent application is currently pending, the drawings show these planes. In particular, attached as EXHIBIT hereto is "ATTACHMENT II" that was submitted in an Amendment dated January 16, 2003 which clearly shows plane P1 and plane 40 in Figure 2. Planes P1 and 40 correspond to the claimed planes P1 and P2. Accordingly, the drawings are believed to be in proper form in this patent application.

### **Claim Objections**

Claims 31, 37, 38, and 44 were objected to because the Examiner was unclear as to how a hemispherical reamer and a less than hemispherical cup disclosed in claims 31 and 38 will produce a cup that when implanted seats flush with the outer rim of the acetabulum as claimed in claims 37 and 44. In one particular embodiment of the claimed invention, flush mounting is achieved by the use of a hemispherical reamer having a first radius, and a cup having a second radius, wherein the first radius is smaller than the second radius. When the less than hemispherical, larger radiused cup is press fit a particular distance

within the smaller radiused, hemispherical reamed cavity, then flush mounting of the cup in relation to the outer rim of the acetabulum would be achieved. Claims 31, 37, 38, and 44 are believed to be in proper form.

### 35 U.S.C. § 102 Rejection

Claims 31, 32, 36-39, and 44 were rejected under 35 U.S.C. § 102 as being anticipated by Amstutz et al. (U.S. Patent No. 4,123,806). Reconsideration of these claims is respectfully requested.

#### Discussion Re: Patentability of Claim 31

##### *Claim 31*

Among the various limitations of claim 31, the following is recited:

wherein said cup body is further configured such that when said imaginary hemisphere is superimposed over said cup body, said upper rim lies in a second plane P2 that is spaced apart from said first plane P1 by a distance D,

wherein  $0.5 \text{ millimeters} \leq D \leq 2.0 \text{ millimeters}$ , and

wherein said cup body is further configured such that when said imaginary hemisphere is superimposed over said cup body, said outer surface of said cup body lies coincident with said imaginary hemisphere from said apex portion to said second plane P2.

In an attempt to identify elements in Amstutz that meet these claimed limitations, the following was stated in the December 5, 2003 Office Action at page 3, lines 4-12:

"Although Amstutz does not specifically recite a reamer having a cutting head configured to ream a hemispherically shaped cavity, *it is inherent that the hemispherical cup 18 would require a hemispherical reamer* (7:6-10). Figures 3 and 5 show the plane (P1) in which the shell forms a 'great circle'. Focusing back on Figure 6, a second plane (P2) that defines an imaginary hemisphere is shown. The cup 18 is can be precisely hemispherical or ... may be 1 or 2

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millimeters less than a hemisphere. This shape would render a distance (D) between the 'great circle' and the imaginary hemisphere that [falls] within the applicants claimed range (6:5-8)." (Emphasis added.)

If, however, as it is alleged above, it is inherent that the hemispherical cup 18 would require a hemispherical reamer, it would appear to logically follow that it is also inherent that a 1 or 2 millimeter less than hemispherical cup would require a 1 or 2 millimeter less than hemispherical reamer. This being the case, in either of these instances, the claim limitations of claim 1 identified above are not met. Indeed, in the first case, the use of a hemispherical cup and a hemispherical reamer would not meet the claim limitations identified above including the limitation that "said upper rim lies in a second plane P2 that is spaced apart from said first plane P1 by a distance D." Moreover, in the second case, the use of a 1 or 2 millimeter less than hemispherical cup and a 1 or 2 millimeter less than hemispherical reamer also would not meet the claim limitations identified above including the limitation that "said upper rim lies in a second plane P2 that is spaced apart from said first plane P1 by a distance D." Indeed, in both of these cases in Amstutz, the first plane P1 would lie coincident with the second plane P2. It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Thus, claim 31 is not anticipated by Amstutz.

Discussion Re: Patentability of Claims 32, 36, and 37

Each of claims 32, 36, and 37 depends directly from claim 31. As a result, each of claims 32, 36, and 37 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 31.

Discussion Re: Patentability of Claim 38

The discussion regarding the patentability of claim 31 is relevant to the patentability of claim 38. As a result, claim 38 is allowable over the cited art.

Discussion Re: Patentability of Claims 39 and 44

Each of claims 39 and 44 depends directly from claim 38. As a result, each of claims 39 and 44 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 38.

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**35 U.S.C. § 103 Rejection**

Claims 33-35 and 40-43 were rejected under 35 U.S.C. § 103 as being unpatentable over Amstutz et al. (U.S. Patent No. 4,123,806) in view of Pratt et al. (U.S. Patent No. 5,888,205) Reconsideration of these claims is respectfully requested.

Discussion Re: Patentability of Claims 33-35

Each of claims 33-35 depends directly or indirectly from claim 31. As a result, each of claims 33-35 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 31.

Discussion Re: Patentability of Claims 40-43

Each of claims 40-43 depends directly or indirectly from claim 38. As a result, each of claims 40-43 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 38.

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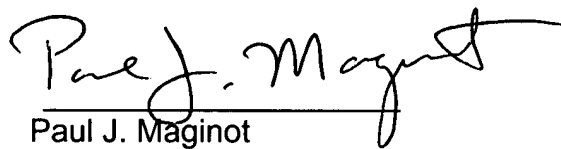
**Conclusion**

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In view of the foregoing remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

Respectfully submitted,

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